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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/596,878

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Yoshitaka Nishio

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EXAMINER

LEE, LAURA MICHELLE

ART UNIT

PAPER NUMBER

3724

MAIL DATE

DELIVERY MODE

12/16/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/596,878	Applicant(s) NISHIO, YOSHITAKA	
	Examiner LAURA M. LEE	Art Unit 3724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 8/27/2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 8 is/are rejected.
- 7) ☒ Claim(s) 5-7 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to the amendment filed on 8/27/2009 in which claims 1-8 are pending, claims 1 and 5 are currently amended.

Specification

2. The amendments to the specification are acceptable.

Drawings

3. The drawings were received on 8/27/2009. These drawings are acceptable.

Claim Objections

4. Claim 1 is objected to because of the following informalities:
Claim 1, line 14, "tuning axis" should be --turning axis--.
Appropriate correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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6. Claims 1-4 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Galindez (U.S. Patent 4,372,471). Galindez discloses a scribing line forming mechanism (Figure 9) comprising: a scribing line forming means (cutter wheel, 101) being structured so as to form a scribing line on a substrate by contacting the substrate, and the scribing line forming means is configured to move on a surface of the substrate and to form the scribing line on the surface of the substrate along a movement path line (i.e. H) of the scribing line forming means; and a supporting means (cutter assembly, 105 / bearing housing 123) for supporting the scribing line forming means (wheel, 101) such that the scribing line forming means (101) is turnable about a first turning axis (defined by axis of cylindrical stub portion, 135), the supporting means (105/123) being structured so as to be turnable about a second turning axis (pivot point between arm T and arm S; Figure 12), the second turning axis (TS pivot) being different from the first turning axis (at 135), wherein the axial center of the first turning axis and the axial center of the second turning axis are approximately in parallel (both are vertical axis) and the axial center of the second turning axis (TS pivot) is distant by a predetermined interval (i.e. approx. by the length of arm S) from a portion where the substrate and the scribing line means forming means contact each other and the axial center of the second tuning axis is substantially perpendicular to a surface of the substrate.

It is noted that the limitation of "is distant by a predetermined interval" does not imply a constant or fixed interval. Applicant should also note that the limitations scribing line forming means are not in compliance with the Supplemental Guidelines published in the Official Gazette on July 25, 2000. Such limitations cannot be used to invoke 35

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USC 112, 6th paragraph, and have therefore been given their broadest reasonable interpretation, without considering equivalence.

In regards to claim 2, Galindez discloses wherein the scribing line forming means includes a cutter wheel (101), and the supporting means (105/123) includes a cutter supporting means (105/102) for the cutting wheel (101) such that the cutter wheel is rotatable (at 102).

In regards to claim 3, Galindez discloses wherein the supporting means (105/123) includes a bearing (bearing, 108) for supporting the scribing line forming means (101).

In regards to claim 4, Galindez discloses a scribing line forming mechanism according to claim 1; and a pressure application means (i.e. piston 118/ fluid cylinder, 111) for applying a pressure force to the scribing line forming mechanism in order to press the scribing line forming means onto the substrate.

In regards to claim 8, Galindez discloses a moving means (motor, M and pneumatic cylinder) for moving the scribing head on a surface, the surface being approximately parallel to the substrate, such hat the scribing line forming means forms the scribing line of the substrate.

Allowable Subject Matter

7. Claims 5-7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: The prior art fails to teach a scribing line forming mechanism with a scribe line forming means rotatable about a first axis parallel yet different from the axis of a supporting means that is further supported by a first supporting means rotatable about a third axis perpendicular (vertical) to the first two axes and also with a restriction means that restrains the turning of the first supporting means by contact.

Response to Arguments

8. Applicant's arguments filed 8/27/2009 have been fully considered but they are not persuasive. The applicant does not agree that Galindez anticipates claim 1 as now amended. The applicant claims that Galindez does not disclose that "the scribing line forming means is configured to move on a surface of the substrate and to form the scribing line on the surface of the substrate along a movement path line of the scribing line forming means (specifically the movement path line of the second turning axis)." However, the limitations "movement path line" are not so specific to only refer to the movement path line of the second turning axis and instead also read on the displacement movement of the cutter on the substrate. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the path movement line of the turning axis) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LAURA M. LEE whose telephone number is (571)272-8339. The examiner can normally be reached on Monday through Friday, 8:00am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer Ashley can be reached on (571) 272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Laura M Lee/

Examiner, Art Unit 3724

12/14/2009

/Boyer D. Ashley/

Supervisory Patent Examiner, Art Unit 3724